

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 09/855,142

Confirmation No. 1124

Applicant: Lincoln, et al.

Filed: May 14, 2001

TC/AU: 2145

Examiner: Azizul Q. Choudhury

Docket No.: 211202 (Client Reference No. F32396US)

Customer No.: 23460

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
PURSUANT TO 37 C.F.R. §1.8(b)(3) AND MPEP § 512, OR, IN THE
ALTERNATIVE, PETITION TO REVIVE FOR UNINTENTIONAL
ABANDONMENT**

Sir

Applicants' attorneys received a Notice of Abandonment mailed from the U.S. Patent and Trademark Office ("PTO") on October 3, 2007 (copy enclosed) in the above-referenced patent application. The Notice alleges that the PTO did not receive a Reply to the Office Action mailed May 2, 2006. The Notice further states that a Reply filed on July 24, 2007 and received in the Office on August 2, 2007 is not an appropriate response to the aforementioned Office Action because the response period had expired when the referenced Reply was received.

Applicants petition to withdraw the holding of abandonment in this application pursuant to 37 C.F.R. 1.8(b)(3) and MPEP § 512 because a timely Reply was filed to the Office Action mailed May 2, 2006 and to the Communication mailed January 24, 2007. In support of this Petition, Applicant's attorneys state the following:
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1. On February 8, 2006, Applicants filed an RCE in order to have a previously unconsidered Amendment considered by the Examiner. (See Exhibit A hereto.)

2. On February 15, 2006, Applicants filed a Request for Interview, requesting an interview prior to issuance of any new Office Action if the Examiner considered the application not to be in condition for allowance following entry of the previously-filed Amendment, now to be considered as a result of the filing of the February 8, 2006 RCE. The Request included a Certificate of Mailing signed by Kathleen N. Grantz, former secretary to the undersigned. (See Exhibit B hereto.)

3. Despite the outstanding Request for Interview, an Office Action was mailed on May 2, 2006. The Office Action did not address the outstanding Request for Interview.

4. On November 2, 2006, Applicants' attorneys filed a Reply to the Office Action mailed on May 2, 2006 and authorized the \$1,020.00 fee for a three-month extension of time to be charged to its Deposit Account No. 12-1216. The Reply included a Certificate of Mailing dated November 2, 2006 signed by Kathleen N. Grantz, former secretary to the undersigned. A copy of the Reply with Certificate of Mailing is enclosed as Exhibit C.

5. Applicants' attorneys also enclosed a postcard receipt with the Reply, which was returned by the PTO bearing the PTO's receipt stamp of "Nov 07 2006" and which evidences receipt of the Reply to Office Action in the PTO. This receipt date appears to be accurate for a document mailed on November 2, 2007. A copy of this postcard is enclosed as Exhibit D. The undersigned additionally certifies that Ms. Grantz made such mailing, as further evidenced by the postcard.

6. Applicants' attorneys note during a review of PAIR that scanned copies of the Extension of Time and the Reply to Office Action mailed November 2, 2006 appear under the Available Documents tab for the application, and both also contain the PTO's receipt stamp of "Nov 07 2006." Copies of these documents are enclosed as Exhibit E.

7. The Reply dated November 2, 2006 (see Exhibit C) properly detailed the reasons that the Office Action of May 2, 2006 was improper. Among other things, the Reply identified the following:

- The May 2, 2006 Office Action issued without the scheduling of an interview as specifically requested by the Applicants. It appears that the Request had been overlooked at the time that the Office Action issued.
- The May 2, 2006 Office Action did not indicate that Applicants' prior remarks had been deemed persuasive, or that the prior rejections had been withdrawn.

The May 2, 2006 Office Action did not provide an explanation as to why the Applicants' remarks and amendments had not been deemed persuasive.

Accordingly, the rejections of the December 21, 2005 Office Action still remain in the file and were repeated in the present Office Action, placing a cloud over the claims. Applicants had no way of determining why the arguments and amendments were not deemed persuasive, however. As set forth in the MPEP at § 707.07(f), the examiner must answer the substance of Applicants' arguments. As a result, the May 2, 2006 Office Action was improper, and should have been withdrawn or supplemented as requested.

- The previously filed Reply to Office Action set forth an extensive recitation of the "Distinctive Features of the Present Invention." The outstanding Office Action does not so much as mention this recitation of the Applicants' previously filed Reply. The MPEP, however, specifically states that "If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record." *Id.* The outstanding Office Action makes no such mention of the features explained in detail in the prior Reply. Accordingly, Applicants had no way of knowing if such features have been considered, or if such features were considered unpersuasive. As a result, the May 2, 2006 Office Action was improper, and should have been withdrawn or supplemented as requested.
 - While the May 2, 2006 Office Action cited new references and has furnished copies of two non-patent references, the copies provided did not show the date of the references. Accordingly, Applicants were unable to access the appropriateness of the references as prior art to the invention. As a result, the Office Action was improper, and should have been withdrawn or supplemented as requested.
8. For each of these reasons, the May 2, 2006 Office Action was improper and remains improper. The Notice of Abandonment does not address the latter three of the bullet points identified above and in the Reply filed November 2, 2006.

9. In its Reply dated November 2, 2006 (see Exhibit C), Applicants refer to their prior observations regarding the Hart reference and applies the same to the Reed reference, therefore providing a substantive response to the rejections cited in the May 2, 2006 Office Action despite the fact that the Office Action itself was improper.

10. On January 24, 2007, the Office issued a Communication requiring the filing of an agenda for an interview (see Exhibit F), response to the Communication being due within 30 days, which deadline was extensible by 5 months.

11. On July 24, 2007, Applicant filed a Reply to Office Communication and Submission of Interview Agenda with the Office. The Reply further included a request for five-month extension of time to respond and authorization to charge deposit account for the fee in the amount of \$2,160.00. That Reply included a proper Certificate of Mailing signed by Jacqueline Vega, a former temporary secretary to the undersigned. (See Exhibit G.) Also included is a return post card evidencing the Office receipt of the Reply on August 2, 2007. Accordingly, Reply to the January 24, 2007 Communication was properly and timely filed.

12. In reviewing PAIR, Applicants' attorneys note that this document appears in the file wrapper of the application with the PTO stamp of "AUG 02 2007" and also contains a stamp reflecting charge of the \$2,160.00 fee to the Deposit Account. A copy of the document printed from PAIR is enclosed as Exhibit H. The undersigned additionally certifies that the same was appropriately mailed by Ms. Vega. If the Reply had not been timely filed, the Office would not have charged the Deposit Account for the \$2,160.00 fee.

13. The Notice of Abandonment asserts that the Office Action of May 2, 2006 was proper regardless of the lack of requested interview. As an initial matter, the undersigned notes that the interview was properly requested on February 15, 2006. While the undersigned respectfully disagrees with the statement that an interview request was not properly filed, the undersigned additionally notes that the properly filed November 2, 2006 Reply to Office Action sets forth numerous reasons for the improper nature of the Office Action in addition to the non-recognition of the outstanding Request for Interview. Those reasons are outlined above in paragraph 7. Among the reasons, the Office Action must answer the substance of Applicants' arguments; the Office Action must specifically state if the asserted advantages are not sufficient to overcome the rejections; and the Office Action did not provide appropriate copies of the non-patent references for assessment by Applicant. Thus, even if

the Office need not have considered the Request for Interview at that time, the Office Action was still improper.

14. The Notice of Abandonment further asserts that the Reply filed November 2, 2006 is not responsive to the May 2, 2006 Office Action. The undersigned respectfully disagrees. Beyond the identifications of the shortcomings of the Office Action necessitating withdrawal or issuance of a supplemental Office Action, the Reply specifically states that the arguments related to the Hart reference are also applicable to the Reed reference. Without an appropriate response to the prior remarks presented by Applicants (as was required by not provided by the Office Action of May 2, 2006), Applicants properly responded.

15. The Notice of Abandonment asserts that the Reply to Office Communication and Submission of Interview Agenda filed July 24, 2007 did not substantively respond to the outstanding Office Action. Applicants respectfully submit that response beyond that provided was not possible without further supplementation of the prior Office Action to comply with the MPEP. Applicants have continually sought guidance from the Office regarding why their arguments have not been deemed persuasive, as well as a dated copy of the cited non-patent references. In order to understand the same, Applicants have submitted an agenda for interview as required by the Communication with the July 24, 2007 Reply.

16. Finally, the Notice of Abandonment asserts that the Reply to Office Communication and Submission of Interview Agenda was not timely filed. Applicants notes that the Reply included a proper, signed Certificate of Mailing and the PTO apparently charged the deposit account of the undersigned a fee of \$2,160. (See Exhibit G.) Clearly, such fee would not have been charged by the Office if the Reply was not properly filed. Accordingly, the Reply to the January 24, 2007 Communication was properly and timely filed.

17. Should the Office require additional evidence or attestation of mailing of Replies, the undersigned would be happy to supply the same.

18. In conclusion, Applicants submit that the Notice of Abandonment is improper in that it is based upon inaccurate information, including inaccurate statements that Replies were not timely filed, that the Office Action of May 2, 2006 was proper, and that Applicants did not substantively reply to the May 2, 2006 Office Action. Accordingly, the Notice of

Abandonment is improper and should be withdrawn. Further, a complete Office Action should be provided, and a date should be set for the interview.

Applicants believes that since the abandonment of the application is due to errors made by the PTO, that no fee is due in connection with filing this Petition. However, the Commissioner is authorized to charge a Petition fee in the amount of \$130.00 pursuant to 37 CFR 1.17(h), if appropriate, or any other appropriate fee associated with this communication and to credit any excess payment to Deposit Account No. 12-1216.

Should the Office persist in its position, Applicants alternatively request that this Petition be treated as a Request to Revive Application Due to Unintentional Abandonment, and authorize the Office to charge the fee of \$1,540.00 pursuant to 37 C.F.R. §1.17(m) to Deposit Account No. 12-1216.

Respectfully submitted,



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